

## **REMARKS**

### **A. Status of the Claims**

As set forth in the August 3, 2006 Decision on Applicant's Pre-Appeal Brief Conference Request, claims 1-8, 11-13, 17, 19, 20, 22, 24, 25, 27, and 28 stand rejected; claims 64-69 stand allowed; claims 18, 21, 23, and 26 stand objected to; and claims 9, 10, 14-16, and 29-63 stand withdrawn. Claim 1 has been amended for the reasons set forth below.

### **B. Examiner Interview**

On August 23, 2006, Applicant's representative Mark Garrett and Examiner Han discussed the applicability of U.S. Patent No. 6,379,331 to Barbut *et al.* (Barbut) to the rejected claims. Examiner Han agreed that amending claim 1 to recite that the claimed guidewire is sufficiently flexible to navigate the spinal subarachnoid space would distinguish needle 66 in Barbut. Examiner Han indicated that amending claim 1 in this fashion would necessitate a further search.

### **C. The Rejected Claims Are Patentable over Barbut**

The Office rejects claims 1, 4-7, 11-13, 24 and 27 as being anticipated by Barbut. Applicants have amended claim 1 for the sole purpose of even more clearly distinguishing Barbut. Claim 1 now recites, in relevant part, percutaneously introducing a guidewire into the spinal subarachnoid space at an entry location, *the guidewire being sufficiently flexible to navigate the spinal subarachnoid space*. Barbut's needle 66 fails to teach or suggest the recited flexibility. For this reason, claim 1 and its rejected dependent claims are patentable over Barbut.

### **C. Claim 2 Is Patentable**

The Office rejects claim 2 as being obvious over Barbut in view of U.S. Patent No. 6,328,694 to Michaeli. Michaeli does not cure Barbut's failure to disclose or suggest the use of a

guidewire. Furthermore, there is no motivation to combine Michaeli's background teaching about brain tissue removal with the teachings of Barbut, which pertain only to methods and devices that can be used to cool and re-circulate CSF, to arrive at a modified Barbut technique for which no need exists. *See In re Nomiya*, 184 USPQ 607, 612-613 (CCPA 1975) (holding that it is improper to conclude that an invention is obvious absent evidence that one of ordinary skill would have recognized that an underlying problem existed).

**D. Claim 3 Is Patentable**

The Office rejects claim 3 as being obvious over Barbut in view of U.S. Patent No. 4,904,237 to Janese. Janese does not cure Barbut's failure to disclose or suggest the use of a guidewire.

**E. Claims 8, 19 and 20 Are Patentable**

The Office rejects claims 8, 19 and 20 as being obvious over Barbut in view of U.S. Patent No. 6,004,262 to Putz *et al.* (Putz). Putz does not cure Barbut's failure to disclose or suggest the use of a guidewire.

Furthermore, one could not introduce an endoscope or detector through either of the catheter ends in Barbut without changing the principle of operation of Barbut. Barbut is designed to create a CSF cooling and re-circulation loop for a patient. Nothing in Barbut even remotely suggests that the introduction of other instruments or structures through his catheters can or should interrupt that process, or that his system should be modified to accept their introduction. The Office is improperly picking and choosing from disparate disclosures to arrive at the claimed subject matter, and its bare assertion for a motivation is not supported by substantial evidence. *See In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001) ("With respect to core factual findings in a determination of patentability, however, the Board cannot simply reach

conclusions based on its own understanding or experience – or on its assessment what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.”); MPEP § 2144.03 at 2100-138 (“It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence on which the rejection was based.”) (citing *In re Zurko*, 258 F.3d at 1386).

#### **F. Claims 17 and 22 Are Patentable**

The Office rejects claims 17 and 22 as being obvious over Barbut in view of U.S. Patent No. 5,423,760 to Yoon. Yoon does not cure Barbut’s failure to disclose or suggest the use of a guidewire.

Furthermore, with respect to claim 17, one could not introduce an apparatus through either of the catheter ends in Barbut and apply electric current, heat or cryothermal stimulation to a tissue with the apparatus without changing the principle of operation of Barbut. Barbut is designed to create a CSF cooling and re-circulation loop for a patient. Nothing in Barbut even remotely suggests that the introduction of other structures through his catheters can or should interrupt that process, or that his system should be modified to accept their introduction. The Office is improperly picking and choosing from disparate disclosures to arrive at the claimed subject matter, and its bare assertion for a motivation is not supported by substantial evidence. See *In re Zurko*, 258 F.3d at 1386 (“With respect to core factual findings in a determination of patentability, however, the Board cannot simply reach conclusions based on its own understanding or experience – or on its assessment what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.”); MPEP § 2144.03 at 2100-138 (“It is never appropriate to rely solely on common

knowledge in the art without evidentiary support in the record as the principal evidence on which the rejection was based.”) (citing *In re Zurko*, 258 F.3d at 1386).

**G. Claim 25 Is Patentable**

The Office rejects claim 25 as being obvious over Barbut in view of U.S. Patent No. 6,233,488 to Hess. Hess does not cure Barbut’s failure to disclose or suggest the use of a guidewire.

Furthermore, one could not introduce an electrode through either of the catheter ends in Barbut and place the electrode within a living being without changing the principle of operation of Barbut. Barbut is designed to create a CSF cooling and re-circulation loop for a patient. Nothing in Barbut even remotely suggests that the introduction of electrodes through his catheters can or should interrupt that process, or that his system should be modified to accept electrodes for placement. The Office is improperly picking and choosing from disparate disclosures to arrive at the claimed subject matter, and its bare assertion for a motivation is not supported by substantial evidence. See *In re Zurko*, 258 F.3d at 1386 (“With respect to core factual findings in a determination of patentability, however, the Board cannot simply reach conclusions based on its own understanding or experience – or on its assessment what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.”); MPEP § 2144.03 at 2100-138 (“It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence on which the rejection was based.”) (citing *In re Zurko*, 258 F.3d at 1386).

#### **H. Claim 28 Is Patentable**

The Office rejects claim 28 as being obvious over Barbut in view of U.S. Patent No. 5,731,284 to Williams. Williams does not cure Barbut's failure to disclose or suggest the use of a guidewire.

Furthermore, one could not introduce genetic material into a patient through either of the catheter ends in Barbut and place the genetic material within the living being to assist in treating a neurologic condition without changing the principle of operation of Barbut. Barbut is designed to create a CSF cooling and re-circulation loop for a patient. Nothing in Barbut even remotely suggests that genetic material introduction through his catheters can or should interrupt that process, or that his system should be modified to allow for the introduction of such material. The Office is improperly picking and choosing from disparate disclosures to arrive at the claimed subject matter, and its bare assertion for a motivation is not supported by substantial evidence. *See In re Zurko*, 258 F.3d at 1386 ("With respect to core factual findings in a determination of patentability, however, the Board cannot simply reach conclusions based on its own understanding or experience – or on its assessment what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings."); MPEP § 2144.03 at 2100-138 ("It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence on which the rejection was based.") (citing *In re Zurko*, 258 F.3d at 1386).

## **I. Conclusion**

Claims 1-8, 11-13, 17-28, and 64-69 are in condition for allowance. Examiner Han is invited to contact the undersigned attorney at (512) 536-3031 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

/Mark T. Garrett/

Mark T. Garrett  
Reg. No. 44,699  
Attorney for Applicant

FULBRIGHT & JAWORSKI L.L.P.  
600 Congress Avenue, Suite 2400  
Austin, Texas 78701  
(512) 474-5201  
(512) 536-4598 (facsimile)  
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